

## **REMARKS**

Applicant, by the amendments presented above and the arguments presented below, has made a concerted effort to present claims which clearly define over the prior art of record, and thus to place this case in condition for allowance. Claims 1-41 are currently pending. Claims 39-41 are newly added.

### ***Specification***

The Examiner requested that Applicant review all continuing data for accuracy and completeness, and that the status of the parent application should be updated where appropriate.

In view thereof, Applicant has amended the continuing data in the specification to state that Application Serial Number 09/921,091, entitled “Cartridge Insert Which Fits Into A Box” and filed August 2, 2001, issued as United States Patent No. 6,685,025 on February 3, 2004.

The Examiner also objected to the Abstract of the Disclosure because, in the Examiner’s opinion, the word “cooperates” in line 7 should be changed to – cooperate –, and in the last line the phrase “which prompted the invention” is considered unnecessary and should be deleted. The Applicant has amended the Abstract of the Disclosure accordingly and has attached hereto a clean copy of the Abstract of the Disclosure as amended on a separate sheet.

### ***Drawings***

The Examiner objected to the drawings because, in his opinion, Figures 9A-10F have rough and blurry numbers and lines. As such, Applicant encloses replacement drawings for Figures 9A-10F, which are a better quality than those filed on October 21, 2003, as well as replacement drawings for Figures 1-8 for continuity purposes. Please find enclosed:

Sheet one	-	Fig. 1;
Sheet two	-	Fig. 2;
Sheet three	-	Figs. 3A, 3B, 3C, 3D, 3E and 3F;
Sheet four	-	Figs. 4, 5 and 6;
Sheet five	-	Fig. 7;
Sheet six	-	Fig. 8;
Sheet seven	-	Fig. 9A;
Sheet eight	-	Fig. 9B;
Sheet nine	-	Fig. 9C;
Sheet ten	-	Fig. 9D;
Sheet eleven	-	Fig. 9E;
Sheet twelve	-	Fig. 9F;
Sheet thirteen	-	Figs. 10A and 10B;
Sheet fourteen	-	Fig. 10C;
Sheet fifteen	-	Fig. 10D;
Sheet sixteen	-	Fig. 10E; and
Sheet seventeen	-	Fig. 10F

Applicant believes that these replacement drawings correspond to the pending drawings, and as such do not introduce any new matter.

Accordingly, it is respectfully requested that these replacement drawings be accepted and entered into the file of the above-captioned application. It is also requested that these replacement drawings be included in the printed Patent.

### ***Claim Rejections - 35 U.S.C. §112***

Claims 14 and 22 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner stated that in claims 14 and 22, the term “portion” is used with regard to the blank as well as the product such that the expressions “folding said first portion” etc. render the claims vague and indefinite because such fails to positively set forth that it is the portions of the blank that are folded.

Applicant has amended claims 14 and 22 to clarify whether the portions identified in the claim are portions of the tubular insert or the product such that Applicant states that the rejection under 35 U.S.C. 112, second paragraph, is overcome.

### ***Claim Rejections - 35 U.S.C. §102***

Claims 1-6, 19 and 20 were rejected under 35 U.S.C. 102(b) as allegedly being clearly anticipated by United States Patent No. 3,291,365 to Koene.

Applicant has amended independent claim 1 in order to distinguish the claimed invention from Koene. Specifically, Applicant has amended independent claim 1 to state that the bottom panel is configured to prevent the product from extending into the bottom air cell. Koene does not disclose or suggest such a configuration. In each of the illustrated and described embodiments in Koene, it is taught to provide a recess (12 or 28) in the “bottom panel” such that the product to be secured bear upon the edges of the recesses (12 or 28), with a bottom of the product extending into the “bottom air cell”, which is clearly illustrated in at least FIGS. 2, 4 and 5. Thus, it is clear that Koene does not teach or disclose the invention as claimed in amended independent claim 1. Further, Koene does not suggest such a

configuration.

Thus, Applicant respectfully requests reconsideration and allowance of independent claim 1 in view of the amendment thereto.

Applicant notes that independent claim 1 has also been amended to change the wording “said first side panel having first means for receiving a first end of the product therein when the product comes into contact with said first side panel” to – said first side panel configured to receive a first end of the product when the product comes into contact with said first side panel – in order to remove the means-plus-function limitation therefrom. Applicant has likewise made a similar change in connection with the second side panel. Applicant states that such an amendment does not affect the patentability of amended independent claim 1.

As claims 2-6, 19 and 20 are all ultimately dependent upon amended independent claim 1, which Applicant states is in condition for allowance, Applicant respectfully requests reconsideration and allowance of claims 2-6, 19 and 20.

#### ***Allowable Subject Matter***

Claims 9-13, 21 and 23-38 were indicated as being allowed by the Examiner. Applicant notes that claim 30 has been amended to: (1) remove the word “adjacent” therefrom as there is no antecedent basis for the phrase “adjacent vertical panels”; and (2) correct a spelling error of the word “vertical”.

Claims 7, 8 and 15-18 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening

claims.

Applicant has amended claim 7 into independent form to include the limitations of independent claim 1 therein. Applicant notes that in amending claim 7 to include the limitations of independent claim 1 therein, Applicant has changed the wording “said first side panel having first means for receiving a first end of the product therein when the product comes into contact with said first side panel” to – said first side panel configured to receive a first end of the product when the product comes into contact with said first side panel – in order to remove the means-plus-function limitation therefrom. Applicant has likewise made a similar change in connection with the second side panel. Applicant states that such an amendment does not affect the patentability of amended claim 7. As such, Applicant respectfully requests reconsideration and allowance of amended claim 7.

Applicant, rather than amending claim 8 into independent form to include the limitations of independent claim 1 therein, has amended claim 8 to be dependent on amended claim 7 rather than independent claim 1. As Applicant states that amended claim 7 is in condition for allowance, Applicant respectfully requests reconsideration and allowance of amended claim 8.

Applicant has amended claim 15 into independent form to include the limitations of independent claim 1 therein. Applicant notes that in amending claim 15 to include the limitations of independent claim 1 therein, Applicant has removed reference to the “receiving means for receiving” (the means-plus-function limitation) an end of the product and has rather identified that each of the side panels have at least one anchor tab which is configured to be folded into the respective air cell when an end of the product comes into contact with the side panel. Applicant states that such an amendment does not affect the patentability of amended claim 15. As such, Applicant respectfully requests reconsideration and allowance

of amended claim 15.

Applicant has amended claim 16 into independent form to include the limitations of independent claim 1 therein. Applicant notes that in amending claim 16 to include the limitations of independent claim 1 therein, Applicant has changed the wording “said first side panel having first means for receiving a first end of the product therein when the product comes into contact with said first side panel” to – said first side panel configured to receive a first end of the product when the product comes into contact with said first side panel – in order to remove the means-plus-function limitation therefrom. Applicant has likewise made a similar change in connection with the second side panel. Applicant further notes that in amending claim 16 into independent form to include all of the limitations of independent claim 1 therein, Applicant has changed some of the wording originally provided for in claim 16 in order to clarify the meaning of the claim. Applicant states that such amendments do not affect the patentability of amended claim 16. As such, Applicant respectfully requests reconsideration and allowance of amended claim 16.

As claims 17 and 18 are dependent upon claim 16, and because Applicant states that claim 16 as amended is in condition for allowance, Applicant respectfully requests reconsideration and allowance of claims 17 and 18. Applicant notes that claim 17 has been amended to change the phrases “co-planar with” therein to – parallel to – in order to more appropriately claim the invention.

The Examiner stated that claims 14 and 22 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, second paragraph, set forth in the Office Action. As explained hereinabove, Applicant has amended claims 14 and 22 to overcome the rejection made under 35 U.S.C. 112, second paragraph and, therefore,

Applicant respectfully requests reconsideration and allowance of claims 14 and 22.

### *Newly Added Claims*

Applicant has added new independent claim 39. Applicant states that independent claim 39 is allowable over the prior art of record, and specifically over United States Patent No. 3,291,365 to Koene, because independent claim 39 has the limitation that “said first side panel and said first side air cell are configured to fold outwardly relative to said bottom panel and said bottom air cell upon receiving the product in order to adjust to different sizes of the product.” This limitation is similar to that in claim 7, but does not require that the first side panel and the first side air cell also be configured to fold inwardly relative to the bottom panel and the bottom air cell upon receiving the product. Koene does not disclose or suggest such a configuration where the “first side panel” and the “first side air cell” are configured to fold outwardly relative to the “bottom panel” and the “bottom air cell” upon receiving the product. Rather, the “first side panel” and the “first side air cell” of Koene are configured to only fold inwardly relative to the “bottom panel” and the “bottom air cell” upon receiving the product. Thus, Applicant respectfully requests consideration and allowance of new independent claim 39.

Applicant has added new independent claim 40. Applicant states that independent claim 40 is allowable over the prior art of record, and specifically over United States Patent No. 3,291,365 to Koene, because independent claim 40 has the limitation “whereby upon said first and second side panels receiving the product, said bottom panel is not pressed downwardly into said bottom air cell and said first and second side panels are not pulled toward one another.” Koene does not disclose or suggest such a configuration where the “bottom panel” is not pressed downwardly into the “bottom air cell” and where the “first and

second side panels” are not pulled toward one another when the “first and second side panels” receive the product. Rather, Koene teaches throughout the specification and drawings that upon receiving the product, whether an egg or an ornament, the “bottom panel” will be pressed downwardly due to the weight of the product, such that the “first and second side panels” are pulled toward one another. See, e.g., Col. 4, lines 10-18. Thus, Applicant respectfully requests consideration and allowance of new independent claim 40.

Applicant has added new independent claim 41. Applicant states that independent claim 41 is allowable over the prior art of record, and specifically over United States Patent No. 3,291,365 to Koene, because independent claim 41 provides for an insert which is capable of receiving and protecting either a first or a second product, where the first and second products have different shapes and configurations. Support for same can be found at least one page 6, lines 21-29 of the continuation-in-part patent application. Koene does not disclose or suggest such a construction or configuration. Rather, Koene states in Column 2, lines 44-58 that Koene provides cutouts (9) which are specifically configured to receive a single type of article having a predefined shape and configuration, e.g., circular cutouts for circular items (Christmas tree balls) or parabolic cutouts for parabolic items (eggs). Thus, Applicant respectfully requests consideration and allowance of new independent claim 41.



In view of the above Amendments and Remarks, Applicants respectfully submit that the claims of the application are allowable over the rejections of the Examiner. Should the Examiner have any questions regarding this Amendment, the Examiner is invited to contact one of the undersigned attorneys at (312) 704-1890.

Respectfully submitted,

Date: September 30, 2005

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